

**REMARKS**

Claims 1-23 are pending in the application.

Claims 1-3, 6-9, 12-14, 16-18 and 20-23 have been rejected.

Claims 4, 5, 10, 11, 15 and 19 have been objected to.

Claims 1, 3, 7, 9, 13, 18 and 21-23 have been amended, as set forth herein.

I. **OBJECTIONS TO CLAIMS 4, 5, 10,11, 15 AND 19**

Applicant thanks the Examiner for the indication that Claims 4, 5, 10, 11, 15 and 19 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant has not elected to rewrite these claims in independent form, at this time.

II. **REJECTION UNDER 35 U.S.C. § 102**

Claims 1-2, 6-8, 12 and 21-23 were rejected under 35 U.S.C. § 102(e) as being anticipated by Saitou, et al. (US 6,451,005). <sup>1</sup> The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed.

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<sup>1</sup> The Office Action refers to Section 102(b), however, Applicant believes that the Office Action intended for the rejection to be based upon Section 102(e).

Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Applicant has amended independent Claims 1, 7, 21, 22 and 23 to recite a plurality of conductors. Saitou does not disclose a plurality of conductors.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(e) rejection of Claims 1-2, 6-8, 12 and 21-23.

### III. REJECTION UNDER 35 U.S.C. § 103

Claims 1-3, 6-9, 12-14, 16-18 and 20-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nita, et al. (US 5,951,539) in view of Saitou, et al. (US 6,451,005). The rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re*

*Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

As described in Applicant's prior responses, Nita generally describes a catheter having a ribbon (or wire) constructed of a variety of different materials. Metallic and non-metallic ribbons, fibrous materials and elastic alloys may be used. Since these types of materials are disclosed by Nita to construct the ribbon, and furthermore, since Nita fails to address or mention electrical stimulation leads or electrodes, Nita only teaches use of a ribbon for mechanical purposes - strength,

torqueability, kink resistance and flexibility. Therefore, Nita's catheter does not have conductors, and Nita fails to disclose a plurality of conductors. See, Nita, Figures 2D, 3C, 6-12.

Similarly, Saitou describes a catheter having a coil wound about the inner layer with different pitches along different portions of the catheter - to provide different rigidity (mechanical) at different points along the catheter. Saitou describes a single coil that "is composed of a metal member and/or a non-metal member." Col. 4, lines 41-42. As such, Saitou only teaches a single coil member used for mechanical purposes, and Saitou fails to disclose a plurality of conductors.

Therefore, the proposed combination of Nita and Saitou fails to disclose, teach or suggest a plurality of conductors or that the inner and outer insulator are fused together (or joined together by melting) - as recited in Applicant's claims.

Additionally, combining Nita and Saitou would not be practical. Nita teaches that the inner layer and the outer layer have different melting points. Saitou teaches using similar materials for the inner and outer layers. See Saitou, Col. 13, lines 35-36. In fact, Nita teaches that:

"Outer layer (572) must be thermoplastic to be useful in the procedure described below. Inner layer (576) is typically lubricious and has a  $T_g$  which is higher than the flow temperature material making up outer layer (572)." Col. 17, lines 40-45. See also, Figures 14A-14G and related discussion, Col. 17, line 33 through Col. 18, line 48 showing the inner and outer layers."

This is not a small point in Nita. Nita teaches that its construction forms various “islands,” which are artifacts created as a result of squeezing the outer layer onto the inner layer with sufficient heat. Col. 16, lines 54-59. Nita is very clear as to the purpose of the “islands.” Nita teaches:

“Although it is believed that these islands are separated by open regions (562), it is believed that this combination of pillars (560) and open regions (562) provide the catheter assembly itself with a great deal of suppleness.” Col. 16, lines 59-67.

Thus, the structure that Nita teaches, a structure that uses “islands” and is necessary to provide Nita’s invention with “a great deal of suppleness,” would not be possible if combined with Saitou. Hence, motivation to combine Nita with Saitou fails, as their two structures are distinct, different and not combination in order to solve their respective problems.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejection of Claims 1-3, 6-9, 12-14, 16-18, 20-23.

#### IV. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

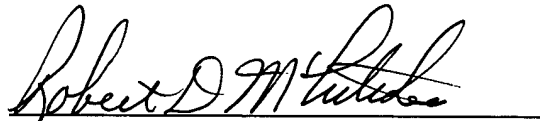
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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